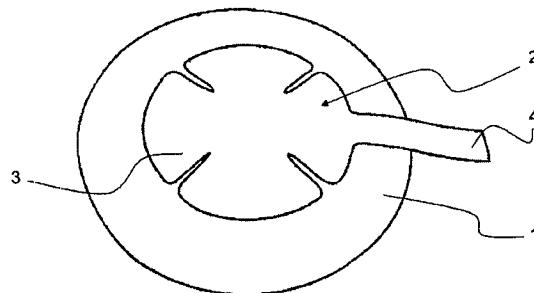


Remarks/Arguments

A. Status of the Claims

Claims 19, 20, and 44 are revised. Claim 19 further defines the outermost layer of the temporary protective coating as a mineral outermost layer. Non-limiting support for this amendment can be found in the specification at page 6, lines 14-15 (“Preferably, the temporary outer protective coating comprises [a] mineral outer layer....”). Claim 19 also includes the element that “the peelable film at least covers the central part of the surface of the lens.” Non-limiting support for this element can be found in Figure 1 of the specification and also at page 5, lines 10-13 (“More precisely, it is usual to deposit the holding pad, associated with the acorn, on the lens convex side. It is therefore possible to cover with the protective coating the whole convex side or, alternatively, only a central area of the convex side, using a mask or any other appropriate technique.”), page 9, lines 3-13 (“According to the invention, the centre part of the temporary protective coating is coated with an electrostatic peelable film 2....”), and page 11, lines 25-27 (“An electrostatic film with a 38 mm diameter having a tab as illustrated on FIG. 1 is applied manually in the middle of the convex side of the glasses, on the other 15 glasses.”). Figure 1 is provided below for the Examiner’s convenience, which illustrates a peelable film 3 that covers the central part of the surface of the lens:



Claims 20 and 44 are revised to conform with the revisions made to claim 19.

Claim 46 is cancelled.

Non-limiting support for new claim 47 can be found in the original claims as filed and in the passages of the specification discussed above with respect to claim 19.

B. Examiner Interview

Applicant's representative, Michael Krawzsenek, and Examiner Robinson, discussed this case *via* telephone on October 15, 2010. This is evidenced by the Interview Summary mailed October 21, 2010. Applicant agrees with the Examiner's summary and provides the following additional comments.

As noted by the Examiner, the definiteness of the language "wherein the peelable film at least covers the central part of the surface of the lens" (see cancelled claim 46) was discussed. Applicant explained that a person having ordinary skill in the art upon considering the specification and Figure 1 would easily be able to identify the central part of a lens (see above comments). Further, this type of phrase is widely used and accepted in the ophthalmic industry. Indeed, 237 U.S. patents have issued since 1976 that use "central part" and "lens" in the claims. Also, the center of a lens is a geometrically defined point that would be easily identified by a person having ordinary skill in the relevant art field, thus satisfying the 35 U.S.C § 112, second paragraph requirements.

Applicant and Applicant's representative thank the Examiner for taking the time to discuss this case in further detail over the telephone.

C. Indefiniteness Rejections

Three separate indefiniteness rejections under 35 U.S.C. § 112, second paragraph, are presented against claims 19, 45, and 46. Given the amendments made to claim 19, the cancellation of claim 46, and the arguments provided in the above sections, Applicant believes that the rejections to claims 19 and 46 are moot.

With respect to the indefiniteness rejection for claim 45 concerning the term “offset,” Applicant respectfully submits that this term is definite. This term is widely used and accepted in the ophthalmic industry, as evidenced by the fact that 3,236 U.S. patents have issued since 1976 that use “offset” and “lens” in the claims. Further, it is well accepted that the offset is a convention parameter that is measured to determine whether an edging operation was successful. Indeed, the International Organization for Standardization provides an ISO standard (ISO 8980-2:2004) for measuring the offset parameter, as evidenced by PCT Publication WO/2007/071700 and U.S. Publication 2010/0200541.

Applicant requests that the indefiniteness rejections be withdrawn for at least these reasons.

D. The Anticipation Rejection in View of Ohlin Should Be Withdrawn

Claims 19, 20, 33, 34, 36, and 46 remain rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,792,537 (“Ohlin”).

Although Applicant respectfully disagrees (see previous responses), claim 19 further defines the outermost layer of the temporary protective coating as a “mineral outermost layer.”

By comparison, Ohlin discloses a coating made of ink marking and does not appear to disclose Applicant’s claimed “mineral outermost layer.”

Applicant requests that the anticipation rejection be withdrawn for at least this reason.

E. The Obviousness Rejection Should Be Withdrawn

Claims 19-22, 25-32, 38-43, and 45-46 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 03/057641 (“Conte”) in view of U.S. Patent 5,451,281 (“Lipman”). Applicant respectfully disagrees with the Examiner’s conclusions for at

least the reasons stated in the previous response, which are incorporated by reference. Applicant provides the following additional comments concerning this rejection.

1. “the peelable film at least covers the central part of the surface of the lens”

Claim 19 now recites that the electrostatic peelable film covers the central part of the surface of the lens.

The Examiner appears to assert that such a feature is disclosed in Lipman by stating that “the film of Lipman (Column 6, lines 40-55) can be adhered to the lens and then the center portion can be removed. Prior to removal, the film, would cover the entire lens....” Action at page 6.

Applicant respectfully disagrees with the Examiner. Lipman fails to disclose or suggest that the peelable film at least covers the central part of the surface of the lens as presently claimed by Applicant. Indeed, the Lipman film is designed to do just the opposite.

For instance, the passage at column 6, lines 40-55, of Lipman, which the Examiner relies on, references Figure 12. Figure 12 is provided below:

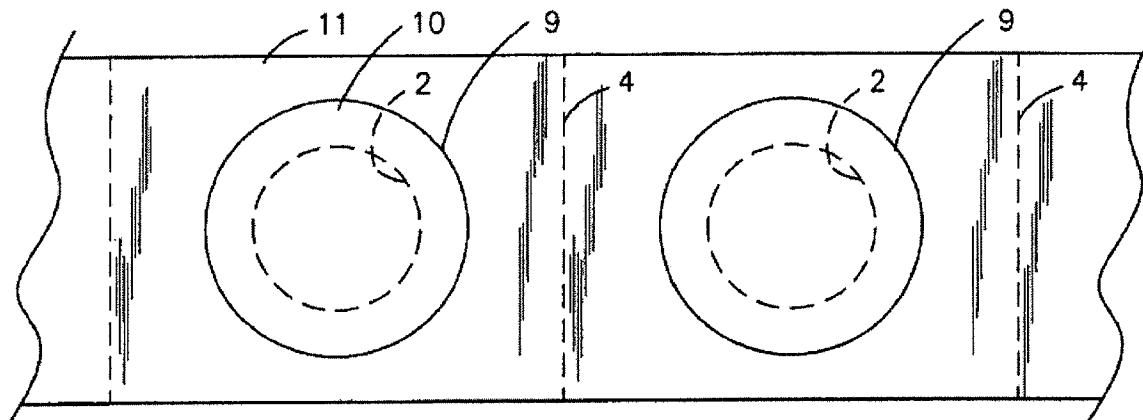


Fig. 12

See also col. 6, lines 40-55. Element 10 is the portion of the film that is designed to be adhered to the lens. Element 9 is a weakening line that is used to remove the excess material 11.

Element 2 is an opening or aperture (col. 5, lines 53-57). This opening or aperture is there for a particular purpose, which is to ensure that the mounting block can make direct contact with the central part of Lipman's lens:

The film is preferably provided in the form of a continuous film 3, with or without perforations 4 imprinted into the film for ease of separation of the film into individual sheets, and with a cut-away 2 provided in each sheet through which the mounting block can contact the lens. After the film has been applied to the lens, excess film protruding beyond the surface of the lens to be protected can simply be cut away.

See also Abstract and Figures 1-11. The element 2 opening or aperture is created **prior to** the film ever being applied to the lens. *Id.* That is, the central part of Lipman's film is always devoid of material when being applied to a lens:

The film of the present invention can be applied by means of the widely available 3M Surface Saver Applicator (in which a continuous film without perforations could be used). **The film can be applied either before the LEAP pad and block are applied, since the film is provided with an opening which leaves exposed the area in which the mounting block is affixed to the lens, or the LEAP pad and block can be applied and then the protective film can be applied around the block.** The opening can be any size and any shape, but considering the objects of the invention, it will be apparent that the film should cover as much as possible of the lens surface area not covered by the block or LEAP pad.

Id. at col. 5, lines 30-42.

Therefore, Figure 12 of Lipman does not represent a film that has material in its central portion. Rather, the dashed lines simply represent an opening or aperture. This is confirmed in the Brief Description of the Drawings (col. 3), which explains that Figure 12 only differs from Figure 9 by the presence of the weakening line 9. Given that Figure 9 is described as showing a film that does not include material in its central portion (col. 3, lines 55-58), the logical conclusion is that Figure 12 is also devoid of such material. Again, the purpose of this design is to ensure that once Lipman's film is applied to a lens, the central part of the lens can be in direct contact with a mounting block.

Further, Applicant submits that there is no apparent reason to redesign or modify Lipman's film to include material in its center portion. Such a modification would add unnecessary steps of first adding the material with the idea that the material would have to be removed prior to edging, which would make Lipman's disclosed process less efficient. Further, such a modification would appear to prevent a user from applying the film to the lens after the block has been affixed to the lens, which is an embodiment contemplated by Lipman ("...since the film is provided with an opening which leaves exposed the area in which the mounting block is affixed to the lens, or the LEAP pad and block can be applied and then the protective film can be applied around the block."). Therefore, this type of modification is contrary to Lipman's design parameters, which is evidence that such a modification is legally flawed. See MPEP § 2143.05(V) and (VI) ("If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification") ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.").

Therefore, the combination of Conte and Lipman fails to disclose or suggest every element of Applicant's claimed invention.

2. The relevance of Applicant's claimed peelable film and the Conte declaration

Peelable film

Applicant's specification explains that an object of the peelable film is to protect the underlying temporary coating during handling, storage, shipping, *etc.* Specification at page 3, lines 8-12 and 19-120. The peelable film is also designed to be removed prior to edging the lens. *Id.* at page 9, lines 14-16. Although the handling/storage/shipping aspects of the film are not part

of the claims, the protection offered by Applicant's claimed peelable film is relevant when considering the motivation to combine Conte with Lipman.

Conte concerns the process of edging a lens and the use of a temporary protective coating to ensure sufficient adhesion between the lens and the chuck during trimming and to protect any underlying layers. Lipman also concerns an edging process and the use of a peelable film specifically designed to protect the lens during edging while also allowing sufficient adhesion of the lens to the chuck *via* an aperture in the film. Nothing in either Conte nor Lipman suggests applying a peelable film to Conte in a non-edging context, such as during storage or handling of a lens. Again, these references concern edging processes and not handling/storage processes. This is highly relevant in that the only apparent and logical reason to combine Conte and Lipman would be to do so in the context of edging a lens.

During edging, the combination of Lipman's film with Conte's temporary coating would result in an aperture in Lipman's film. There is no other way around this conclusion. Conte says its temporary coating provides adhesion to the chuck while also protecting the underlying layers. Lipman says its peelable film needs to have an aperture in the center part to ensure sufficient adhesion to between the lens and chuck. Therefore, the combination fails to disclose or suggest Applicant's claimed element that the "peelable film at least covers the central part of the surface of the lens."

Previous Declaration

The ultimate question becomes whether there is even an apparent reason to combine Conte with Lipman. The Declaration from Dominique Conte submitted by Applicant in its previous response concerns this very question. The answer provided in this Declaration is no. The reasoning for this answer is that Conte's data and the Declaration both confirm that Conte's

temporary coating sufficiently protects its lens during trimming. Thus, why use Lipman's film with Conte's lens if there is no reason to do so?

The Examiner's primary response is that Declaration is "insufficient" in that it "provides no data to show that the additional protective layer of Lipman would not provide any additional protection to the lens." Action at pages 8-9.

Additional data is not required nor is it needed. The Declaration is evidence that there is no apparent reason to combine Conte and Lipman. The MPEP explains that such a Declaration "is entitled to consideration." MPEP § 716.01(c)(III). Applicant requests that the Declaration be given more consideration than it was previously given.

With respect to the Examiner's request to provide data on whether Lipman's film adds no further protection to Conte's coating, Applicant respectfully notes that more data is not needed. The question surrounding the current obviousness rejection is not whether Lipman's film would provide additional protection during edging, but rather whether there is an apparent reason to even use Lipman's film with Conte's temporary coating in view of the teachings of these references. The later question has been answered by the Declaration—there is no reason to combine these references. Given this, then it would appear that the rationale being used by the Examiner to combine these references is based, and least in part, on an improper hindsight reconstruction of the claimed invention.

If the only response by the Examiner to the Declaration is that there is a reason to combine the reference because more protection is always better, then Applicant requests at least some form of evidence or declaration from the Examiner to support this view. *See* 37 C.F.R. § 1.104(d)(2). As it stands now, the evidentiary record favors Applicant on appeal in that Conte's

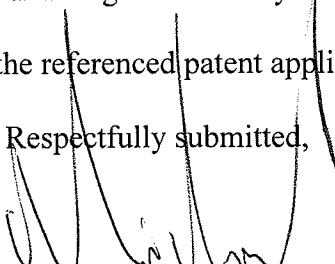
lens needs no further protection—much less protection from Lipman's film. The protection of Conte's lens by its temporary protective layer is completely and satisfactory fulfilled.

Applicant also notes that the Examiner previously argued that the claimed temporary protective coating is not so strong given that it is damaged during the transportation and storage of the lenses. Applicant respectfully notes that the protection required during edging is different when compared with the protection required during transportation and storage. Stated another way, the nature and strength of the stress applied on the surface of the lens during edging is different than during transportation and storage.

Applicant respectfully requests that the current obviousness rejection be withdrawn for at least the above-stated reasons.

F. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Michael R. Krawzenek
Reg. No. 51,898
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
512.536.3020 (voice)
512.536.4598 (fax)

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